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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/597,239 | 06/20/2000 | Kiyoshi Suzuki | PNDF-00040 | 5864 |
| 30743 | 7590 | 11/15/2004 | EXAMINER | |
| WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190 | | | KASSA, YOSEF | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2625 | |

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,239

Applicant(s)

SUZUKI ET AL.

Examiner

YOSEF KASSA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-20 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Arguments

1. Applicant's arguments, (page 9-13) filed on 06/14/2004, with respect to claims 1-5 and 7-20 under Crane, Jr. et al (U.S. Patent 6,307,258) and Setlak et al (U.S. Patent 5,940,526) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Setlak et al (U.S. Patent 6,628,812).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 9, 10, 12, 15, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setlak et al (U.S. Patent 5,940,526).

With regard to claim 1, Setlak et al discloses removing static electricity stored on a finger of a user (see col. 6, lines 10-14) through a plate on finger print reading apparatus (see Fig. 4, item 101) adjacent finger print-reading portion (see Fig. 4, item 54) prior to putting his finger on a fingerprint-reading portion while obtaining access to finger print reading portion by movement of a structure for covering finger print reading portion when not in use (see col. 6, lines 20-26).

Setlak et al does not disclose expressly for removing static electricity stored on a finger through a plate adjacent to finger print-reading portion. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to removing static electricity stored on a finger through a plate adjacent to finger print-reading portion. Applicant has not disclosed that removing static electricity stored on a finger through a plate adjacent to finger print-reading portion provide an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either finger charge bleed process taught by Setlak et al or removing static electricity stored on a finger through a plate adjacent to finger print-reading portion because both process perform the same function, that is, discharging static electricity stored on a finger through ground.

Claim 2 similarly analyzed as claim 1.

With regard to claim 3, Setlak et al discloses forming cover by conductive material, connecting cover with a ground conducting static electricity to a ground via cover when cover is opened by finger of user (see col. 6, lines 27-37).

Claim 4 similarly analyzed as claim 3.

3. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setlak et al (U.S. Patent 5,940,526), and further in view of Setlak et al (U.S. Patent 6,628,812).

Claims 5 and 7 are similarly analyzed as claim 1 and 2. As to the additional limitation of removing static electricity stored on finger of user when user opens a cover

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of another apparatus. At the same field of endeavor, Setlak et al is taught this feature (see Fig. 1 and 2). At the time of the invention was made, it would have been obvious to incorporate the teaching of Sitlak et al static removing process with another Setlak et al reference.

With regard to claim 9, Sitlak et al discloses conductive material is metal (see col. 6, lines 19-24).

Claim 10 is similarly analyzed as claims 1 and 2.

Claims 12, 15 and 18 are similarly analyzed as claim 9.

With regard to claim 20, Sitlak et al conductive material is plastic containing carbon fibers therein (see col. 6, lines 51-65).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 11, 13, 14, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setlak et al (U.S. Patent 5,940,526), and further in view of Fujiwara et al (U.S. Patent 6,310,683).

With regard to claim 8, Setlak et al is silent about conductive material is conductive resin. The same field endeavor, Fujiwara teaches this feature (see col. 11, lines 20-26). At the time of the invention was made, it would have been obvious to

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incorporate a fingerprint reading apparatus as taught by Fujiwara in the system of Setlak et al because Fujiwara provides Setlak et al system a process of reducing an optical loss in reading a fingerprint, eliminating positioning among the respective components and improving the productivity.

Claims 11, 14 and 17 are similarly analyzed as claim 8.

Claim 13 is similarly analyzed as claims 1 and 3. As to the additional limitation of a main cover which is provided with a display, this feature is taught by setlak et al (see Fig. 1, item 37).

Claims 16 and 19 are similarly analyzed as claim 13.

Allowable Subject Matter

5. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other Prior Art Cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. (6,246,566) to Glenn discloses electrostatic discharge protection package and method.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSEF KASSA whose telephone number is (703) 306-5918. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BHAVESH MEHTA can be reached on (703) 308-5246. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communication and (703) 872-9306 for after Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (703) 306-5631. The group receptionist number for TC 2600 is (703) 305-4700.

PATENT EXAMINER

Yosef Kassa



11/12/04.